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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,892	12/14/2000	Takayuki Yamamoto	Q62230	5759

7590

06/19/2002

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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 06/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-4 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-4 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

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1. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, the language in each claim that the formed article is "for use in . . ." is patentably insignificant in that it appears to be an improper attempt to claim a method of use in an article claim.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

4. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth

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in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamamoto et al. The reference, having two common co-inventors and a believed common assignee, discloses (note particularly the Abstract, column 1, line 12 - column 2 line 52, column 3 lines 7-27, column 4 lines 11-28, Examples 1 and 2, column 7 lines 1-20) a pressure sensitive adhesive sheet formed from a suitable acrylic based pressure sensitive adhesive that can have (column 3 lines 15-24) high molecular weight acrylic polymers of the percentage amounts of those which applicants appear to contemplate. Additionally, although the reference is silent with respect to the content of low molecular weight components such as are claimed by applicants, the Examiner believes that applicants' claimed polymer content range of 100,000 or lower molecular weight ^{polymers} is limited to 10% by weight or lower would be either inherent in the formed genus of polymers, or at most an obvious modification to one of ordinary skill, being motivated by such advantages as resource saving and environmental health (note, e.g. column 1 lines 37-40). The polymers are formed by being polymerized in the presence of

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liquid or supercritical carbon dioxide (note, that applicants' claim 1 does not require a certain method of polymerization). With respect to claims 3 and 4, the Examiner believes that in their present state the limitation "for use in semiconductor wafer processing" is patentably insignificant with respect to any additional structure. What other parameters that may still remain that are not either expressly or inherently disclosed are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

7. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0818470A1. The reference discloses (note particularly the Abstract, page 2, lines 5-10, lines 25-37, lines 49-54, page 3 lines 53-57, page 4 lines 6-24, lines 35-46, page 5 line 5 - page 6 line 1, page 6 line 58 - page 7 line 13, particularly lines 3-6) a broad genus of acrylic pressure sensitive adhesives which can be coated onto a suitable substrate to form a sheet and which preferably comprise acrylic copolymers having a number average molecular weight ranging from 10,000 to 500,000. As such, the previously cited, above, molecular weight range set forth in applicants' claim 1 is believed to be, if not inherently disclosed, an obvious modification to one of ordinary skill for the reasons set forth in the prior rejection paragraph, together with the added desire to solve the problems of odors

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associated with residual monomers and of attachment of gels on reactor walls, as well as to provide improved productivity and workability. As before, claim 3 is not seen to recite any meaningful structure in its "for use" clause. What other parameters that are not either expressly or inherently disclosed are each again believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

8. Claims 2 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP -470 taken either individually or in view of De Simone et al. The primary reference is relied upon substantially as set forth above, disclosing a broad genus of acrylic pressure sensitive adhesives formed by a variety of conventional processes. The Examiner initially notes that the polymerization of acrylic based pressure sensitive adhesives in the presence of liquid or supercritical carbon dioxide in claim 2 is also a product-by-process limitation not as yet shown on the record to produce a patentably distinct article. Alternatively, the secondary reference De Simone et al. discloses (column 2 line 72 - column 3 line 56) the utilization of liquid or supercritical carbon dioxide as a valuable medium in which to conduct polymerization reactions of the type applicants contemplate. Accordingly, one of ordinary skill, motivated by an expectation of improved adhesive quality would look to the aforementioned process of polymerization shown by the secondary reference and

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utilize it as the polymerization method of the primary reference to thereby form the claimed genus of embodiments. With respect to the "for use" in the semiconductor wafer art clause set forth in dependent claim 4, this is again handled as previously set forth above.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Hanneman et al.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

June 14, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-

1700

Daniel Zirker